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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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03/29/2000

Deirdre O'Shea

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08/25/2009

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EXAMINER

ALVAREZ, RAQUEL

ART UNIT

PAPER NUMBER

3688

MAIL DATE

DELIVERY MODE

08/25/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/535,790	<b>Applicant(s)</b> O'SHEA ET AL.	
	<b>Examiner</b> Raquel Alvarez	<b>Art Unit</b> 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 2/5/2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-21,23-74,87,94,95,144-154 and 162-165 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-21,23-74,87,94,95,144-154 and 162-165 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. This office action is in response to communication filed on 2/5/2009.
2. Claims 1-3, 5-21, 23-74, 87, 94-95, 144-154, and 162-165

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1-3, 5-21, 23-44, 46-74, 87, 94-95, 144-153 and 162-165 are rejected under 35 U.S.C. 103(a) as being unpatentable over Von Kohorn.**

With respect to claims 1-3, 5-10, 12-21, 23-25, 30-35, 37, 39-41, 43, 44, 46-54, 56, 58, 59, 61-70, 72-74, 87, 94, 95, 144-153 Von Kohorn teaches a method for changing a benefit associated with a coupon (Abstract). Establishing an initial benefit for a coupon (col. 9, lines 11-33); establishing a benefit variation condition for said coupon, said benefit variation condition having at least one associated qualifying action (col. 9, lines 11-33); receiving, via an electronic communication network, notice of a completion of said at least one qualifying action (col. 9, line 34-42); and updating said coupon's benefit in accordance with said benefit variation condition (col. 9, lines 34-42); wherein said qualifying action is associated with a primary recipient of the coupon (col. 9, lines 11-33).

With respect to the newly added feature, Von Kohorn does not specifically teach that one of the qualifying action for varying the coupon is associated with a downstream recipient of the coupon. Official notice is taken that it is old and well known, in chain referral sales, multi-level business pyramids or the like for a seller to induce a buyer to purchase merchandise by promising to give the buyer a discount or a rebate if the buyer furnishes the seller with the names of other prospective buyers. In certain cases, the rebate is paid only if the buyer actually makes a purchase. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included updating benefit of said coupon in association with a first recipient of said coupon and said qualifying action is associated with a second recipient of said coupon, wherein said second recipient is a downstream recipient of said first recipient; providing an indication to said first recipient of a completion of said qualifying action by said second recipient in order to obtain the above mentioned advantage.

With respect to claims 11, 57, 60, 162-165, Von Kohorn teaches a method for changing a benefit associated with a coupon (Abstract). Establishing an initial benefit for a coupon (5-20 % discount)(col. 9, lines 28-33); establishing a benefit variation condition for said coupon, said benefit variation condition having at least one associated qualifying action (i.e. the benefit variation based on the sale of strawberries)(col. 9, lines 33-40); and via a processing device, updating said coupon's benefit in accordance with said benefit variation condition unless a notice is received that said at least one qualifying action has not been completed (i.e. automatically changing the percentage of strawberry discount of 5-20% unless a notice is received that the strawberries are not

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being selling satisfactorily, in that case further changing the discount to an additional 20-40 %)(col. 9, lines 28-42).

With respect to the newly added feature, Von Kohorn does not specifically teach that one of the qualifying action for varying the coupon is associated with a downstream recipient of the coupon. Official notice is taken that it is old and well known, in chain referral sales, multi-level business pyramids or the like for a seller to induce a buyer to purchase merchandise by promising to give the buyer a discount or a rebate if the buyer furnishes the seller with the names of other prospective buyers. In certain cases, the rebate is paid only if the buyer actually makes a purchase. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included updating benefit of said coupon in association with a first recipient of said coupon and said qualifying action is associated with a second recipient of said coupon, wherein said second recipient is a downstream recipient of said first recipient; providing an indication to said first recipient of a completion of said qualifying action by said second recipient in order to obtain the above mentioned advantage.

Claims 3, 5-8, 32-35, 37, 50-54, 57, 60, 63-69, further recite updating benefit of said coupon in association with a first recipient of said coupon and said qualifying action is associated with a second recipient of said coupon, wherein said second recipient is a downstream recipient of said first recipient; providing an indication to said first recipient of a completion of said qualifying action by said second recipient

Claims 25-29, 36, 38, 55 further recite changing the coupon amount if said coupon is redeemed within a predetermined time and said amount is less than the first amount. Official notice is taken that it is old and well known in marketing to start with a

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higher discount and to decrease with time. For example, certain establishments have a lower introductory price on a product or service within a predetermined periods and then changing the price to the regular price in order to induce the customer to try the product or service within the trial period. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included changing the coupon amount if said coupon is redeemed within a predetermined time and said amount is less than the first amount in order to obtain the above mentioned advantage.

Claim 71 further recites crediting a financial account associated with the first recipient if said benefit of said coupon increases after said recipient has redeemed said coupon. Official notice is taken that it is old and well known to credit an account of a customer if a condition takes place after a transaction has been completed. For example, certain establishments will guarantee low prices to their customer by sending or crediting an account of a customer if a sale has taken place after the customer has bought a product. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included crediting a financial account associated with the first recipient if said benefit of said coupon increases after said recipient has redeemed said coupon in order to obtain the above mentioned advantage.

### **Response to Arguments**

4. The 101 rejection has been withdrawn.
5. Applicant argues that Von Kohorn doesn't teach that one of the qualifying action is associated with a downstream recipient of the coupon. The Examiner wants to point

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out that the Examiner had taken official notice of such. In addition to the challenge of the Official Notice taken the Examiner is citing MileNet to support the official notice. MileNet teaches a pyramid type of incentive wherein the user will increase their MileNet points based on having friends and family install and use Milenet. The use and installation of MileNet works as the downstream of the coupon. It would have been obvious to a person of ordinary skill in the art at the art at the time of Applicant's invention to have included in the invention of Von Kohorn the teachings of Milenet because such a modification would allow the users to increase their points based on their friends and families actions.

### **Conclusion**

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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**Point of contact**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Weinhardt can be reached on (571)272-6633. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Raquel Alvarez/  
Primary Examiner, Art Unit 3688

Raquel Alvarez  
Primary Examiner  
Art Unit 3688

R.A.  
8/24/2009